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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,801	07/22/2003	Peter Forsell	2333-122	5300
23117	7590	10/31/2006	EXAMINER YABUT, DIANE D	
NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			ART UNIT 3734	PAPER NUMBER

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,801

Applicant(s)

FORSELL, PETER

Examiner

Diane Yabut

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 182 is/are pending in the application.
- 4a) Of the above claim(s) 5-16, 20-55, 61-77 and 80-82 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 17-19, 56-60, 78 and 79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species I (Figures 1-2) in the reply filed on 11 October 2006 is acknowledged.
2. Claims 5-16, 20-55, 61-77, and 80-82 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected species, there being no allowable generic or linking claim. Election was made without traverse in the reply filed on 11 October 2006.

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

4. The use of the trademarks Parylene, Teflon, and Elaston have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

5. The Summary of the Invention section needs to be shorter or briefer than the Detailed Description. The summary is merely an overview of the prominent features and aspects of the invention.

#### ***Claim Objections***

6. Claims 2-4, 17-19, 57-60 and 79 are objected to because of the following informalities: On line 1 of each of the claims it reads "An implantable constriction device" when it should rather read --The implantable constriction device-- since it is dependent on the implantable constriction device of the independent claim. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 18, and 59 contain the trademarks/trade names Teflon and Parylene. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte*

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*Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a coating on the base material of the implantable constriction device and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1 and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by **Jakobsson** (U.S. Patent No. **5,772,903**).

Claims 1 and 56: Jakobsson discloses an implantable constriction device for forming a restricted stoma opening in the stomach or esophagus of a patient, comprising an elongate composite structure **11**, or elongate means, adapted to constrict the stomach or esophagus of the patient, wherein said elongate composite structure is composed of a base material ("reinforced plastic material") making said composite structure self-supporting, or means for making the

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constricting means self-supporting, and property improving means for improving at least one physical property of said composite structure other than self-supporting properties, (expansible, "elastic, soft plastic material) (Figure 2 and col. 3, lines 55-67 to col. 4, lines 1-6).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2-4, 17-19, 57-60, 78, and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Jakobsson** (U.S. Patent No. **5,772,903**) in view of **Furst** (U.S. Pub. No. **20020099438**).

Claims 2-4, 17-19, 57-60, 78, and 79: Jakobsson discloses the claimed device except for the property improving means comprising a coating on said base material at least along a side of said elongate composite structure that is intended to contact the stomach or esophagus, said coating having better aggressive body fluid resistant properties than said base material and better anti-friction properties than said base material, said coating being selected from the group consisting of a Teflon™, Parylene™, and a biocompatible metal coating selected from the group consisting of gold, silver, and titanium.

Furst teaches property improving means comprising a coating on said base material at least along a side of said elongate composite structure that is capable of contacting the stomach or esophagus, said coating having better aggressive body fluid resistant properties than said base material, said coating being selected from the group consisting of a Teflon<sup>TM</sup> (polytetrafluoroethylene), Parylene<sup>TM</sup>, and a biocompatible metal coating selected from the group consisting of gold, silver, and titanium, and that biocompatible coatings are used to reduce inflammation, infection, irritation, and/or rejection of the device (page 5, paragraph 17). It would have been obvious to one of ordinary skill in the art to provide a coating on the elongate structure, as taught by Furst, to Jakobsson in order to reduce inflammation, infection, irritation, and/or rejection of the device.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane Yabut whose telephone number is (571) 272-6831. The examiner can normally be reached on M-F: 9AM-4PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DY

A handwritten signature in black ink, appearing to read "M. J. Hayes", is written above the printed name.

MICHAEL J. HAYES  
SUPERVISORY PATENT EXAMINER